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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,362

01/05/2004

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AA611

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27752 7590 02/01/2011
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EXAMINER

CHAPMAN, GINGER T

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

02/01/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/751,362	Applicant(s) NAIR ET AL.	
	Examiner Ginger T. Chapman	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,11,22-30 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9,11,22-24,30 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

Claim 1 is amended, claims 1, 9, 11, 22-30 and 32-34 are pending in the application, claims 25-29 are withdrawn from consideration as being drawn to a nonelected invention, claims 1, 9, 11, 22-24, 30 and 32-34 are examined on the merits.

Response to Arguments

Applicant's arguments filed 18 November 2010 have been fully considered but they are not persuasive. Applicant argues the following:

(I) the cited references fail to teach all the claim limitations of claims 1 and 30; Applicant argues that Brandon does not disclose different graphics on diapers contained in a package and the Office action commits error by providing no reasoning why one of ordinary skill in the art would modify Brandon to include a package containing ten or more of the diapers of Brandon (Remarks, page 6 of 14); that the Office action erroneously concludes that the mere disclosure that graphics can be different provides motivation for different graphics on articles contained in a package (Remarks, page 7 of 14).

(II) claim 1 is amended to recite that the graphics are printed directly on the backsheet by reciting that the microporous film material extends from the first waist region to the second waist region; claim 30 is amended to recite a backsheet comprising a sheet of material extending from the first waist region to the second waist region and a printed graphic printed directly on the sheet of material (Remarks, page 7 of 14).

Art Unit: 3761

(III) Pargass discloses a diaper having a graphic on a patch which may be joined to a backsheet (Remarks, page 7 or 14), as such Pargass does not disclose printing graphics directly on backsheets as recited in claims 1 and 30 (Remarks, page 9 of 14);

(IV) the Office action erroneously concludes that the limitations that the graphics are different from each other is drawn to the content of printed matter, Applicant argues that the limitation that the graphics are different from each other is not drawn to the content of the printer when taken in the context of language of the entirety of claims 1 and 30 limitations relating to absorbent articles in a package are drawn to structural differences, not the content of printed matter (Remarks, page 9 or 14).

(V) the claimed common theme of the content of the graphics, differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter (Remarks, page 9 of 14) and the Office action erroneously excises the claimed common theme from claims 1 and 30 without considering the claimed common theme in the context of the claims as a whole (Remarks, page 10 of 14).

(VI) Applicant believes that the Office action has not produced a prima facie case of unpatentability of claims 1 and 30, as such claims 1 and 30 are patentable over the combination of Brandon in view of Yeo and Pargass (Remarks, page 10 of 14)

(VII) claims 9, 11, 22, 23, 24 and 32 are patentable for the reasons discussed above with reference to claims 1 and 30 (Remarks, page 10 of 14).

(VIII) Applicant argues the rejection of claim 11 is erroneous because the Office action states that determining how many diaper articles to place in a package is the result of a mental process, and Applicant believes this assertion is based on subjective reasoning as to why a patent

Art Unit: 3761

should not be granted as opposed to objective rationale based on the rule of law (paragraph bridging page 10 to page 11 of 14).

(IX) Applicant argues claims 33 and 34 are patentable for the reasons claims 1 and 30 are patentable (page 11 of 14) and also recite that graphics are printed in randomly selected order and the articles are placed in the package in the randomly selected order (page 11 or 14).

(X) Applicant argues that the limitation that the graphics have a predetermined association including a common theme of the graphics are not mental processes (Remarks, page 12 of 14); the decision to package the articles in a randomly selected order is not a mental process as to how to decide to package the articles but are structural limitations that define the articles as being stacked in the package in a randomly selected order (Remarks, page 12 of 14). That the articles of Brandon are capable of being placed in a package in a randomly selected order does not render the pending claims obvious (Remarks, page 12 of 14).

(XI) Applicant argues that the Office action's assertion that the structural elements of the diaper do change if their order in the package changes or is rearranged is erroneous because the orders that the diapers are arranged in the package is structural limitation of the absorbent products and thus lends patentable weight. The Office action's assertion that if different patents could issue for the same articles by changing their order in packages, then multiple patents could issue for the same article merely by changing its order in a package is based on subjective reasoning as opposed to objective rationale based on law (page 13 of 14).

(XII) Pargass teaches away from the claimed invention because Pargass teaches articles with repeating graphics instead of random graphics (Remarks, page 13 of 14).

These arguments are not persuasive for the following reasons:

Art Unit: 3761

(I) this argument is not persuasive because the examiner does not use the disclosure that Brandon teaches that the graphics printed on the diapers can be different from each other as motivation to package the diaper articles in packages. The examiner uses this as evidence that Brandon and Pargass are analogous art with respect to diapers that have graphics printed on them and thus are analogous art and the combination of Brandon and Pargass is proper.

With respect to the limitation of packaging the articles in a package of ten articles or more, it is well known in the absorbent article art that it is standard practice to package hygiene articles such as diapers and incontinence pads, sanitary napkins, tampons etc. in numbers greater than ten articles in a package, for sale to consumers. It is standard practice to include ten or more articles in packages based on the fact that several articles may be used within a 24 hour period, and thus one of ordinary skill would be motivated to package the articles for the convenience of a consumer who would prefer to purchase longer-term supplies or quantities of articles, such as ten or more, sufficient to last several days rather than making daily trips to purchase the articles, or rather than making several trips a week to purchase a limited supply of less than ten articles that may only last for a few days.

It is standard practice to place and sell these sanitary articles such as diapers in packages to protect them from the outside environment and keep them clean and sanitary before use because consumers wear these articles in close contact with their body, this is evidenced by the fact that unpackaged diapers, sanitary napkins, tampons etc. are never sold “loose” or unpackaged, or without packaging because the sanitary articles would become contaminated and dirty during transport and storage and a consumer would not purchase unclean or contaminated diapers etc. to place in close contact with their body or with their infant children or toddlers’

Art Unit: 3761

body. The examiner cites the fact that Brandon discloses graphics for proper motivation to combiner with Pargass, not for motivation to place the diapers in packages because providing sanitary articles in packages containing more than ten articles in the package for sale to consumers is standard practice.

The examiner cites the fact that Brandon discloses many selections of different types of graphics printed on diapers as evidence that Pargass is analogous art with respect to diapers having graphics because Pargass teaches articles with many different graphics printed on them and thus one of ordinary skill in the art at the time the invention was made would be motivated to look to the teachings of Brandon and Pargass with respect to whether or not ten or more diaper articles that have different graphics printed on them are capable of being placed together within diaper packaging . Pargass clearly teaches that diapers that have different graphics, such as the diapers disclosed by Brandon, and teaches also that ten or more diapers having graphics wherein the graphics have predetermined associations, as recited in claims 1 and 30, are fully capable of being placed in packages.

Therefore, packaging diapers with graphics is not a novel or nonobvious feature of the claimed invention since it is well-known to package diapers with graphics in packages for the convenience of the consumer. Therefore this argument is not persuasive.

With respect to the prior art not teaching all of the limitation of claims 1 and 30, this is the only limitation that Applicant argues the prior art Brandon does not teach, Pargass teaches this limitation and is analogous art for the reasons above and thus is properly combined with Brandon, thus this limitation is taught by the prior art, and therefore the argument that the prior art does not teach all claim limitations is not persuasive.

Art Unit: 3761

(II) that claim 1 is amended to recite that the graphics are printed directly on the backsheet by reciting that the microporous film material extends from the first waist region to the second waist region; and that claim 30 is amended to recite a backsheet comprising a sheet of material extending from the first waist region to the second waist region and a printed graphic printed directly on the sheet of material is not persuasive because (i) Brandon discloses the graphics can be printed directly on garment-facing surfaces of backsheets, backsheets are known to extend from the first waist region to the second waist region, Yeo which is analogous art directed toward diapers including graphics, is cited for teaching backsheets 10 that form the entire diaper outer cover, said backsheet comprising a laminate of a sheet of nonwoven facing layer 12, a sheet of microporous film 14 with graphics 16 printed directly on the garment-facing surface of the microporous film that comprise the backsheets (column 4, lines 9-30 and column 5, lines 50-54), and further teaches that the microporous film 14 that the graphics 16 are printed directly on, provides a desirable printing substrate because it is breathable and also because its smooth surface provides a good printing substrate, as detailed in the analysis of the claims below.

Yeo teaches the microporous film 14 comprises the backsheet of the diaper, backsheets extend from the first waist region to the second waist region, and thus Yeo teaches this claimed limitation. Therefore this argument is not persuasive.

(III) that Pargass discloses a diaper having a graphic on a patch which may be joined to a backsheet (Remarks, page 7 or 14), as such Pargass does not disclose printing graphics directly on backsheets as recited in claims 1 and 30 (Remarks, page 9 of 14); is not persuasive because the examiner does not cite Pargass for teaching printing directly on a backsheet, this feature is

Art Unit: 3761

disclosed by Brandon, as detailed in the analysis of the claims. Pargss is cited for teaching that it is known in the art to package diapers having graphics wherein the graphics are different from each other, in packages of ten or more articles.

(IV) with respect to the argument that the content of the graphics are structural limitations of the article and are not printed matter, this argument is not persuasive because Applicants' arguments allege that the content of graphics is structural, but Applicant does not specifically point out any facts or reasoning to support this allegation. Applicant does not say why or provide any reasons as to how or why the content of the graphics are are not printed matter, Applicant does not specifically point out or provide any reasons or explanations as to how or why the content of the graphics comprise structural limitations, Applicant merely asserts that the content of the graphics are structural limitations and are not printed matter without providing any evidence, facts or reason or arguments in support of this allegation or assertion. Therefore Applicant's arguments amount to a general allegation that the content of the graphics are structural limitations without specifically pointing out how the content of the graphics are structural limitations, and thus are not persuasive arguments sufficient to overcome the rejection.

(V) with respect to Applicants arguments that the claimed common theme of the content of the graphics, differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter and the Office action erroneously excises the claimed common theme from claims 1 and 30 without considering the claimed common theme in the context of the claims as a whole, this argument is not persuasive because the examiner does not excise the claimed common theme from the claims, the examiner has in fact considered the claimed common theme in the context of the

Art Unit: 3761

claims as whole. The examiner notes that diapers having printed graphics wherein the content of the graphics are not related to a common theme would have the substantially identical structure as diapers where the content of the graphics are related to a common theme.

Furthermore, based upon this consideration and based on the rational underpinnings of law as outlined in the MPEP § 2112.01, III, “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability... The critical question is whether there exists and new and nonobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983).

Here, it is known and taught to print diaper graphics on microporous film comprising diaper backsheets because of its desired breathability properties and also provides a smooth substrate surface for printing, thus there does not appear to exist any new and unobvious functional relationship between the instant printed matter and the substrate; where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.

The cited prior art expressly teaches that it is known to print diaper graphics having different contents on microporous film comprising backsheets as claimed. The prior art also teaches that it is known to provide the graphics having themes that are suitable ornaments for entertaining or amusing the intended wearers thereby making the purchase of the diapers more attractive to a consumer. Thus there appears to be no new and unobvious functional relationship between the printed graphics and the microporous film material substrate, thus the claimed limitations have not been ignored but have been analyzed in detail with respect to the scope and

Art Unit: 3761

contents of the prior art, the differences between the prior art and the claims at issue, resolving the level of ordinary skill in the pertinent art, and considering objective evidence present in the instant application considering obviousness or nonobviousness. Based upon these considerations, Applicants' arguments are not persuasive and therefore the examiner respectfully traverses Applicants' arguments and maintains the art rejections of the rejected claims.

(VI) the examiner maintains that the Office action has provided detailed analysis based upon the teachings of the prior art and the factual inquiries set forth under 35 USC 103(a) for establishing a background for determining obviousness of the instant claims, additionally, Applicant asserts that a prima facie case is not made, but has not specifically pointed out how the language of the claims patentably distinguishes them from the references.

(VII) Applicants' arguments with regard to dependent claims 9, 11, 22, 23, 24 and 32 have been fully considered but are not persuasive as Applicants' arguments depend entirely on Applicants' arguments regarding the rejection of claims 1 and 30, which have been addressed supra.

(VIII) With respect to the argument that rejection of claim 11 is erroneous because the Office action states that determining how many diaper articles to place in a package is the result of a mental process, and Applicant believes this assertion is based on subjective reasoning as to why a patent should not be granted as opposed to objective rationale based on the rule of law (paragraph bridging page 10 to page 11 of 14), Applicants' attention is directed to the previous Office action at page 8, paragraph 24, in light of the well known practice of packaging items in a manner most convenient for a purchaser, providing articles to the purchaser in one package as opposed to two packages or three packages is not a novel or patentable feature, therefore the

Art Unit: 3761

single package or two packages limitations does not lend additional patentable weight and is an obvious modification. *Ormco Corporations and Alless Orthodontic Appliances, Inc. v. Align Technology, Inc.* (Fed. Cir. 05-1426, 8/30/2006).

Because Applicant has not specifically pointed out how determining how many diapers to place in a package for sale is distinguished from mental processes, and because it is known to package articles in multiple and single unit packaging, it appears that the claimed limitation of a package containing greater than 10 diapers, in combination with the other elements recited in the claim, yield the predictable result of diapers having graphics printed on breathable backsheets for sale in packages of ten diapers or more. Therefore the examiner's position is based on the teachings of the prior art and applicable law, thus Applicant's arguments amount to a general allegation that the examiner's position is based on subjective reasoning rather than objective rational based on rule of law is not persuasive.

(IX) With respect to claims 33 and 34 are patentable for the reasons claims 1 and 30 are patentable (page 11 of 14) and also recite that graphics are printed in randomly selected order and the articles are placed in the package in the randomly selected order (page 11 of 14). These arguments are not persuasive because, as noted supra, Applicant has not specifically pointed out how selecting a random order of graphics based on the content of the graphics placing them in a package in a randomly selected order comprises a structural limitation of the articles since rearranging the order of the articles in the package does not change any of their structural features. Therefore this argument is not persuasive to overcome the teachings of the prior art.

(X) with respect to the limitation that the graphics have a predetermined association including a common theme of the graphics are not mental processes; the decision of how to

Art Unit: 3761

package the articles in a randomly selected order is not a mental process but are structural limitations that define the articles as being stacked in the package in a randomly selected order; that the articles of Brandon are capable of being placed in a package in a randomly selected order does not render the pending claims obvious (Remarks, page 12 of 14). This argument is not persuasive because it amounts to a general allegation that the predetermined association and themes of the content of the graphics are a structural limitation but Applicant has not specifically pointed out how or why or in what manner they comprise structural limitation, Applicant does not explain how the themes and associations of the content of the graphics relate to the structure of the diaper, and Applicant does not provide any reasons why this limitation renders the claims nonobvious over the cited prior art.

(XI) the Office action's assertion that the structural elements of the diaper do change if their order in the package changes or is rearranged is erroneous because the orders that the diapers are arranged in the package are structural limitation of the absorbent products and thus lends patentable weight. The Office action's assertion that if different patents could issue for the same articles by changing their order in packages, then multiple patents could issue for the same article merely by changing its order in a package is based on subjective reasoning as opposed to objective rationale based on law. These arguments are not persuasive because Applicant alleges that the order of the articles in the package are structural limitations not the result of mental processes but has not specifically pointed out any facts, reasons, evidence or arguments in support of this allegation.

(XII) Pargass teaches away from the claimed invention because Pargass teaches articles with repeating graphics instead of random graphics is not a persuasive argument because Pargass

Art Unit: 3761

teaches articles with graphics, the graphics are capable of being repeating or random to the substantially identical extent that the instant articles with graphics are capable of being repeating or random because this is the result of how the seller of the articles groups the articles together for packaging and sale to a purchaser. Additionally, the disclosure of the reference of a preferred embodiment does not teach away from the entire disclosure of the patent, all of which must be considered in the analysis of obviousness, *In re Burckel*, 201 USPQ 67, 70. Pargass teaches diaper articles with graphics printed thereon and the content of the graphics and it would be within the ordinary skill of a routine worker in the art to order the articles in any desired order since it appears the diapers would perform equally well if their graphics were in a random or repeating order.

Therefore the examiner respectfully traverses Applicants' arguments and maintains the art rejections of the rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3761

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 9, 11, 22-24 and 30, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon et al (US 5,818,719) in view of Yeo et al (US 5,503,076) and further in view of Pargass et al (US 6,558,499 B1).

With respect to claims 1 and 30, as best depicted in Figure 3, Brandon discloses an absorbent product 10 comprising: a topsheet 36, a backsheet 34, and an absorbent core 32 disposed between the topsheet and the backsheet, the topsheet and the backsheet defining a first waist region (fig. 2A) longitudinally opposed to a second waist region (fig. 2A), wherein the first and second waist regions are connectable with each other to form a waist opening 22 (figs. 1 and 2), each of the absorbent articles further comprising a visible framing mark 74 and a printed graphic 38 (column 10, lines 42-53) 42 (column 7, line 65 to column 8, line 5) printed directly on the backsheet (column 3, lines 49-50); and

wherein all of the printed graphics of the articles have a predetermined association (column 7, lines 8-10 and lines 19-21; column 10, lines 33-34; column 3, lines 19-30);

wherein the backsheet of each of the absorbent articles comprises a sheet of material 66 extending from the first waist region to the second waist region (**claim 30**);

wherein the backsheet of each of the absorbent articles comprises a film material 66 extending from the first waist region to the second waist region (column 10, lines 42-45 and lines 66-67) and having a body facing surface and a garment facing surface (**claim 1**), and wherein each printed graphic is printed directly on the sheet of material 66 (**claim 30**); on the garment facing surface of the film material (**claim 1**) (column 10, lines 66-67; column 3, lines 19-30); and

Art Unit: 3761

wherein the backsheet 14 of each of the absorbent articles further comprises a nonwoven material 92 joined with the garment facing surface of the film material 66 (column 9, lines 35-44 and column 10, lines 61-67 to column 11, lines 1-3; column 3, lines 45-49), and wherein the printed graphic is visible through the nonwoven material (fig. 3; column 7, lines 6-24); and

wherein the predetermined association includes a common theme (column 7, lines 6-24);

Brandon discloses the claimed invention except for the film is a microporous film material. Brandon discloses that the graphics 38, 42 are printed directly film material 66 and the film material 66 extends from the first waist region to the second waist region because the film material comprises the entire outer cover 14 (column 5, lines 45-50; column 10, lines 42-45, lines 65-67 to column 11, lines 1-3) , i.e. the nonwoven material 92 and the film material 66 are a laminate that forms the entire outer cover 14 and thus necessarily the entire outer cover extends from the first to the second waist region. Therefore the only difference between the claims at issue and the teachings of Brandon is that Brandon does not disclose that the film material of Brandon is microporous.

Brandon provides motivation for the graphics to be printed directly on the film comprising the backsheet and at column 3, lines 31-32, provides motivation for areas of "breathability" on the diaper article. At column 5, lines 50-54, Yeo provides motivation to provide breathable film for the backsheet layer and teaches that providing breathable backsheets are well known in the art by forming microporous films to comprise the backsheets, and Yeo further teaches at column 8, lines 44-48 that it is preferable to print graphics directly on microporous film surfaces because they provide a smoother substrate surface to print on than

Art Unit: 3761

non-woven surfaces and therefore permits greater print pattern definition and thereby display improved graphics.

As best depicted in Figure 1, Yeo teaches a diaper 20 backsheet 40 comprising a microporous film (c. 5, ll. 49-50) with graphics printed directly on the garment facing surface of the film and the backsheet 10 further comprises a nonwoven material 12 joined with the film and the graphic is visible through the nonwoven (c. 4, ll. 22-24).

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize microporous film for the backsheet film of Brandon as taught by Yeo since Yeo states, at c. 8, ll. 45-47 and at c. 4, ll. 26-27, that the advantage of forming the backsheet with this design is that the microporous film provides a smooth surface to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

Brandon discloses the claimed invention except for the product comprises a package and at least n absorbent articles are contained in the package, wherein n is greater than 10, the printed graphic of each of the n absorbent articles is different from the graphic of each of the remaining articles. Brandon, at column 7, lines 8-10 and lines 19-21; column 10, lines 33-34; column 3, lines 19-30, discloses the graphics can be different and discloses many selections of different graphics, thus providing motivation for different graphics.

As best depicted in Figure 1, Pargass teaches products comprising a package of at least n absorbent articles wherein n is greater than 10 (column 5, lines 1-5), the articles comprising backsheets comprising films and nonwoven and graphics 21 printed directly on the films comprising the backsheet (column 7, lines 1-15) and the printed graphic of each of the n

Art Unit: 3761

absorbent articles is different from the graphics of each of the remaining articles, see Abstract; see also column 5, lines 2-5 teaching that the package can contain repeating graphics, thus Pargass teaches that the package can contain articles where each printed graphic is different from the graphics on the remaining articles and can also comprise repeating graphics as desired by the packager of the articles. See also column 2, lines 9-13, teaching that printed graphics having predetermined associations are known in the art.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article in packages and with graphics that are different from each other or repeating since Pargass teaches that how to package the graphics and what the content of the graphics are is purely a matter of choice, when there is a variety of possible selections as to how to package the graphics it means that the designer can choose any selection of graphics in packages that he wants.

With respect to the limitation that the graphics on the articles are different from each other, the examiner notes that this limitation is drawn to the content of the graphics and thus is drawn to the content of printed matter.

With respect to printed matter, the critical question is whether any new and unobvious relationship functional relationship exists between the printed graphic and the substrate, as per MPEP § 2112.01, III. Here, both the instant and the prior art graphics are printed on microporous film with nonwoven material comprising the outer cover of the article and the printed graphic is visible through the nonwoven. Outer covers are known in the art to comprise laminates of films and nonwovens in multiple layers, and therefore the claimed graphics do not define any new and unobvious functional relationship between the printed matter and the

Art Unit: 3761

substrate. Therefore the prior art anticipates the claimed limitation in accordance with § MPEP 2112.01, III, as reproduced infra.

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, ³⁶⁷ F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate."). MPEP § 2112.01, III.

It is well known in the packaging art to provide packaging elements with ornamental graphical and product information to induce potential consumer interest. Therefore the selection of graphics would have been within the level of ordinary skill and obvious for the reason of providing advertisement, identification or information about the product or ornamental graphics to induce consumer interest in the article. Therefore the theme, i.e. content of the graphics does not lend additional patentable weight because if articles were patented based on differences in

Art Unit: 3761

graphics, multiple patents could issue indefinitely for the same article by simply changing the content of the graphic.

With respect to claim 9, as best depicted in Figures 1-4, Brandon discloses the common theme include cartoon characters, transportation means, animals and seasonal themes; the examiner notes that this limitation is drawn to the content of the graphics and thus are the content of printed matter, see paragraphs 19-20 supra with respect to the manner in which the content of printed matter are examined in accordance with MPEP § 2112.01, III.

With respect to claim 11, Brandon discloses the claimed invention except for n is selected from 11 to 120. Pargass teaches n is selected from 11 to 120 (column 5, lines 4-5). The examiner notes that selecting the number of articles to include in a package is a mental determination, i.e. the result of a mental process; however, mental processes or processes of human thinking are not patentable even if they have practical application. By way of example, if there were 121 or 122 articles in the package instead of 120 as claimed, a separate patent would not issue for the package containing 121 articles, therefore the number of articles in the package does not lend additional patentable weight.

In light of the well known practice of packaging items in a manner most convenient for a purchaser, providing articles to the purchaser in one package as opposed to two packages or three packages is not a novel or patentable feature, therefore the single package or two packages limitation does not lend additional patentable weight and is an obvious modification. *Ormco Corporations and Allesse Orthodontic Appliances, Inc. v Align Technology, Inc.* (Fed. Cir. 05-1426, 8/30/2006).

Art Unit: 3761

With respect to claims 22 and 32, Brandon discloses the claimed invention except for expressly disclosing that each of the printed graphics is an inkjet printed graphic. Brandon discloses the graphics are printed, thus providing motivation for printing the graphics but remains silent on the method of printing. Yeo, at column 8, lines 66-67 and column 9, lines 5-10, provides motivation for inkjet printing graphics for absorbent articles. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to print the graphics of Brandon by inkjet printing as taught by Yeo since Yeo states, at column 8, lines 66-67 and column 9, lines 5-10, that the advantage of using inkjet printing is that the process can handle multi-color printing and can print directly on a microporous film with no fouling of equipment and provides bright colors and sharp patterns.

With respect to claims 23 and 24, Brandon discloses the claimed invention except for microporous film. Brandon discloses the sheet of material extending from the first to second waist region is film and the graphic is printed directly on the garment facing surface of the film (**claim 23**), thus providing motivation for such; and discloses a nonwoven material joined with the garment facing surface of the film and the printed graphic is visible through the material (**claim 24**), thus providing motivation for such. As best depicted in Figures 2 and 3, Yeo teaches microporous film 14 and the graphics (fig. 3) printed directly thereon, a nonwoven material 12 joined thereto and the graphic is visible through the material 12 (column 4, lines 20-30). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the article of Brandon as taught by Yeo since Yeo states, at column 4, lines 21-30, that the advantage of using microporous film to print graphics upon is that the film surfaces provides colorful graphics which are visually appealing because microporous films

Art Unit: 3761

provides smooth surfaces to support multi-colored printed graphics and the nonwoven protects the graphic from abrasion and provides a more cloth-like look and feel to the outer surface of the diaper.

Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandon in view of Yeo and Pargass and further in view of Stavrulov (WO 00/13632).

With respect to claims 33 and 34, the combination of Brandon, Yeo and Pargass disclose the claimed invention except for the articles stacked in the package in a randomly selected order. The combination discloses the predetermined association includes a common theme, see claims 1 and 30 supra, thus providing motivation for such.

The examiner notes that the limitations of a predetermined association and a common theme among the graphics is not a structural limitation of the article and therefore does not serve to further limit the article.

The dictionary definition of “predetermined” is “to decide something at an earlier time” (Cambridge International Dictionary of English). The dictionary definition of “association” is, inter alia: something linked in memory or imagination with a thing or person; the process of forming mental connections or bonds between sensations, ideas, or memories (Merriam-Webster Online Dictionary). The dictionary definition of “theme: is “a subject or topic of discourse or of artistic representation; a specific and distinctive quality, characteristic or concern (Merriam-Webster Online Dictionary). Therefore the limitation of a predetermined association including a common theme is not a structural limitation of the article but rather is drawn to a mental process and therefore does not lend additional patentable weight.

Art Unit: 3761

With respect to the limitation that the articles are stacked in the package in a randomly selected order, the selected order in which a seller of the articles places the articles in the package is not a structural limitation of the product but is the result of a mental decision on how the package the articles in a manner attractive to a consumer. Deciding to package the diapers in randomly selected orders or non-randomly selected orders is the result of a mental process, i.e. selecting how to distribute and sell the diapers is a marketing strategy of offering for sale products packaged in a manner which makes the purchase thereof attractive to a consumer.

By way of non-limiting examples, the diapers in the package can be taken out of the package and rearranged in an entirely different order that is non-random or random and the diapers can be then replaced into the package; each diaper can also be provided in a single package, or provided unpackaged as promotional samples. The structural elements of the diapers do not change if their order in the package is rearranged differently thus the order in which the diapers are placed in the package does not affect the diaper structure. Therefore this limitation does not lend additional patentable weight.

If products were patented based on simply changing the order in which they are placed in a package, multiple patents could issue indefinitely for the same product merely by placing them in a package in a different order. Additionally, the articles of Brandon are fully capable of being placed in a package in a randomly selected order.

In the alternative, the combination of Brandon, Yeo and Pargass disclose the claimed invention except for the printed graphics are printed in a randomly selected order, the combination discloses the articles placed in the package in a variety of orders, thus providing motivation to package the articles in a variety of orders (Pargass, column 5, lines 1-5).

Art Unit: 3761

The dictionary definition of "random":

Main Entry: **ran-dom**

Pronunciation: \ˈran-dəm\

Function: noun

Etymology: Middle English, succession, surge, from Anglo-French randun, from Old French randir to run, of Germanic origin; akin to Old High German rinnan to run — more at RUN

Date: 1561

: a haphazard course

— **at random** : without definite aim, direction, rule, or method <subjects chosen at random>

(source: Merriam Webster Online Dictionary).

Stavrulov teaches absorbent articles comprising graphics wherein the graphics are printed in a randomly selected order. Stavrulov teaches that the graphics can be either in a randomly selected order or non-randomly selected order as desired by the designer depending on the intended end use, i.e. such as graphics for informational, educational, and instructive or for entertainment and amusement, and the number of articles being provided to the consumer. Stavrulov teaches non-random graphics such as: graphics and text linked by common subjects, ideas, a series of pictures linked by a common plot (page 5, page 9), and consecutive stages from Disney cartoons (page 11), i.e. a story told in sequential order which is not random.

Stavrulov teaches random graphics such as fragments of text and titles of literary works (page 2); interesting trivia facts and observations; advice given – advice given would necessarily be random since the particular advice provided in any given graphic would not be related in any way to any particular situation the consumer may need to be advised in at the moment they encounter any particular graphic (page 5); puzzles and rebuses, conundrums, patterns – patterns

Art Unit: 3761

can be ordered patterns or random patterns, and can be abstract meaningless patterns; ornaments (page 5); independent images, which suggests images not associated with each other in any way and thus random (page 8); graphics of automobile models, breeds of trees, architectural monuments, textual fragments (page 9); unequal ornaments and riddles with a degree of dissimilarity and which do not coincide with each other (page 11).

Stavrulov teaches that the type of graphics and their random or non-random nature depends on the prospective purpose and kinds of households the graphics are intended to attract. Stavrulov further teaches that these graphics can have a positive effect of the emotions of a consumer to attract the consumer to purchase and enjoy the articles (page 4) and that if the graphics become familiar and routine, the attractiveness to the consumer may diminish with time (page 3), thus providing motivation for a degree of randomness to keep the articles and graphics exciting for the purchasers thereof.

Therefore, in view of the teachings of Stavrulov, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the graphics of Brandon, Yeo and Pargass in either randomly selected order or in non-randomly selected order in order to provide the benefits Stavrulov discloses. The examiner notes that when there is an almost limitless variety of possible graphics and orders to choose from, the choices illustrate that the graphics provided is purely a matter of choice; when there is a variety of possible choices, it means that the designer can choose any graphics in any order that he wants.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ungpiyakul et al (US 5286543 A) discloses reference marks for printing graphics directly on films and film / nonwoven laminates comprising backsheets.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/
Examiner, Art Unit 3761
01/29/11

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit
3761